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EXAMINER

CARTER, MONICA SMITH

ART UNIT PAPER NUMBER

3722

DATE MAILED: 07/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/920,207

Applicant(s)

LEE, BRIAN CRAIG

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

✓ On page 3, line 21, element "2" could not be located in the drawings.

✓ On page 3, line 26, element "4" could not be located in the drawings.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ In-claim 8, line 2, the recitation "said textual and graphical information" lacks proper antecedent basis.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, 7-9 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohno et al. (5,424,523).

Ohno et al. disclose a record medium comprising a base layer (2a), at least one magnetic layer (2c) adapted to record magnetically encoded information and in contact with the base layer, at least one ink receptive layer (2d) in contact with the at least one magnetic layer, the at least one ink receptive layer adapted to absorb ink thereon (see col. 5, lines 9-14).

Regarding claim 2, the base layer supports the magnetic printing media and allows the magnetic printing media to be transported through the printer (see col. 5, lines 13-14).

Regarding claim 3, the base layer is capable of being printed on since the base layer is made of plastic and it is well-known in the art that plastic has a printable surface.

Regarding claim 5, see the above rejections to claims 1 and 3.

Regarding claims 7 and 8, the magnetically encoded information comprises text (see col. 3-11).

Regarding claim 9, see the above rejections to claim 1.

Regarding claims 17-19, the method of making the magnetically encoded printed document is inherently disclosed in the above rejections.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno et al. in view of Fryberg et al. (5,916,673).

Ohno et al. disclose the claimed invention except for the at least one ink receptive layer comprising a surface that is coated onto the at least one ink receptive layer to increase the ink receptivity of the surface.

Fryberg et al. disclose recording sheets for ink jet printing wherein the print media is coated with cationic polymers, inorganic pigments, fillers, etc. to increase their ability to absorb ink (see col. 4, lines 34-41).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohno's invention to include a coating on the ink receptive layer that increases ink receptivity, as taught by Fryberg et al., to retain the printing received on the ink surface that would diminish over time without the use of the coating.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno et al. in view of Hashiba et al. (5,747,156).

Ohno et al. disclose the claimed invention except for explicitly disclosing the magnetic material being selected from the group of materials as claimed (one of which being Fe).

Hashiba et al. disclose magnetic recording medium comprising a base (2) and a magnetic recording layer (3) formed on the base. The magnetic recording material layer "may be prepared by another method of forming a metal or an alloy such as Fe, Fe-Cr,

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Fe-Co or Co-Cr on the base 2 by vacuum deposition, sputtering or plating." (see col. 4, lines 13-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohno's invention to provide the magnetic material selected from materials comprising a metal or alloy, as taught by Hashiba et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

9. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broschow et al. (4,114,032) in view of Ohno et al., as used above.

Broschow et al. disclose magnetic printing media to verify the authenticity of a document comprising a base layer and a layer of magnetizable material. Broschow et al. disclose the claimed invention except for claimed invention except for the particular arrangement of the layers of the magnetic media.

Ohno et al. disclose a recording medium as set forth in the above rejections to claim 1. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Broschow's invention to include a printing media having the above disclosed arrangement, as taught by Ohno et al., to provide a secure document that contains encoded information that can not be easily reproduced.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broschow et al. in view of Ohno et al. and further in view of Fryberg.

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Broschow, as modified by Ohno et al., disclose the claimed invention except for the printable surface of the base layer comprising a surface that is coated onto the base layer to increase the ink receptivity of the surface.

Fryberg discloses recording sheets for ink jet printing wherein the print media is coated with cationic polymers, inorganic pigments, fillers, etc. to increase their ability to absorb ink (see col. 4, lines 34-41).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Broschow's invention to include a coating on the base layer that increases ink receptivity, as taught by Fryberg et al., to retain the printing received on the surface that would diminish over time without the use of the coating.

### ***Conclusion***


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bland et al. (5,427,842) disclose tear resistant multilayer films, Fassler et al. (5,764,429) disclose magnetic writing, Yau et al. (2002/0015902) disclose a water-resistant protective overcoat and Japanese Patent (2002-49318) disclose a flexible magnet sheet.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Monica S. Carter  
July 14, 2002